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In Touch
With the Under Secretary for IP

James E. Rogan

*Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office*

I took the oath to become the under secretary of commerce for intellectual property and director of the United States Patent and Trademark Office (USPTO) on December 7, 2001. I am honored and grateful for this opportunity, and I will do all I can to be worthy of President Bush's faith in me, and the United States Senate's unanimous approval of my nomination. Most of all, I will work very hard to be worthy of leading the fine group of people that comprise the USPTO.

During my service in Congress, the men and women of the USPTO had a reputation of being professionals of the highest order. I learned first-hand that this was a well-deserved impression, and that remains even truer today. I particularly want to commend Commissioner Nick Godici for all the fine work he did as acting under secretary and director during the past year. Nick has done an outstanding job of leading the agency during a period of considerable transition and challenge, and I know I speak for the entire IP community in saying that we all are grateful for his tremendous service.

Strengthening our economy is one of the Bush administration's highest priorities, and the importance of intellectual property in supporting that effort cannot be overstated. A strong economy means more jobs, and that is just what this nation's inventors and entrepreneurs do--create jobs. Our role at the USPTO is to help them along by issuing and registering high quality patents and trademarks in a timely manner.

The strong economy this administration seeks to perpetuate is a global one. Here again, the USPTO has a vital role to play. I

intend to use my position as under secretary for IP to make sure we reach out to our foreign trading partners and to encourage their support for strong intellectual property laws and enforcement systems. Companies in the United States continue to sustain tremendous losses abroad through piracy and ineffective enforcement. Working closely with my colleagues in the Bush administration, and my former colleagues in Congress, I will do all I can to reverse this trend and put an end to counterfeiting and the theft of our country's most valuable and inexhaustible resource--American ingenuity.

If we are to accomplish our goals of quality, timeliness and IP protection, we need adequate resources. I will be working closely with the administration and Congress in the coming months to ensure that the USPTO has the money and human resources we need to do the job.

It is a great honor for me to serve as head of an agency that is as old as the country itself. America, known for its ingenuity, has the best intellectual property system in the world. Working with all of you in the IP community, we will do more than merely sustain this marvelous heritage: we will create an even more effective and efficient system. I look forward to that challenge and the opportunities that lie ahead.

This Month in History

January 6 - Patent #1,522,176 was granted in 1925 to George Washington Carver of Tuskegee, Alabama, for cosmetics.

January 16 - Actress Lillian Russell received a patent for a trunk-dresser in 1912.

January 27 - Patent #223,898 was granted in 1880 to Thomas A. Edison of Menlo Park, New Jersey, for "an electric lamp for giving light by incandescence."

James E. Rogan Sworn in as Under Secretary for IP

by Richard Maulsby, Director, Office of Public Affairs

James E. Rogan was sworn in as Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (USPTO) on December 7, 2001. Secretary Don Evans presided over the ceremony. Judge Rogan becomes the 55th head of the agency. He was nominated by President George W. Bush on May 25, 2001, and confirmed by the United States Senate on November 30, 2001.

Judge Rogan manages USPTO's operations and is principal policy advisor to the Bush Administration on all domestic and international intellectual property matters. He also co-chairs the National Intellectual Property Law Enforcement Coordination Council, which oversees domestic and international intellectual property enforcement among federal and foreign entities.

Among Judge Rogan's top priorities are securing adequate funding to improve the quality and minimize the processing times of patents and trademarks, as well as strengthening enforcement of patent, trademark, and copyright protections worldwide.

Judge Rogan was a member of the United States House of Representatives from 1997 to 2001, where he served on both the House Commerce Committee and the House Judiciary Committee. His service on the Judiciary Committee's subcommittee on Courts and Intellectual Property earned him a reputation as a leader on both the protection of intellectual property and the modernization of intellectual property laws to protect America's economic interests. As a member of the Judiciary Committee's Subcommittee on Immigration, Judge Rogan was a leader in helping to increase the number of H1-B immigration visas that are critical to America's high-tech community.

After finishing law school and passing the bar examination, Judge Rogan did a short stint as a corporate litigator in one of Los Angeles' top law firms. A year later, he became a Los Angeles County Deputy District Attorney, where he was a prosecutor in the

Hardcore Gang Murder Unit. There he routinely prosecuted some of society's worst murderers.

Named by *California Lawyer Magazine* as one of the states most effective prosecutors, he soon became California's youngest sitting state court judge in 1990, and served as presiding judge until his election to the California State Assembly in 1994. During his freshman term, he was elected Majority Leader, and was named by the respected *California Journal* as number one in integrity and number one in effectiveness in the California State Assembly.

Judge Rogan, in 1996, was elected to the United States House of Representatives, where he served two terms. He served as a House Manager in the United States Senate impeachment trial of President Clinton, after which he was defeated for reelection in November 2000, in his Democrat-majority district. Appointed a local board member of the Selective Service System by President Ronald Reagan in 1981, Judge Rogan recently retired from that post after completing 20 years of voluntary service.

Judge Rogan earned a B.A. degree from the University of California at Berkeley in 1979, and his J.D. from UCLA School of Law in 1983, where he was a member of the *UCLA Law Review*. He and his wife Christine were married in 1988; they have twin daughters, Dana and Claire born in 1992.



Neither History Nor Culture Does This Paper Be

by James E. Rogan, Under Secretary for IP

Contrary to the impression left by the *New York Times* story that appeared during the holidays, no original patent documents are being discarded by the United States Patent and Trademark Office (USPTO). I'm sure that many of you are aware of that fact, but I wanted to take this opportunity to assure everyone. First, there is nothing of historic or cultural value in the duplicate paper photocopies of patents that the USPTO is eliminating as it moves to more efficient and effective electronic search systems for the agency's 3,000 patent examiners. Thus, there are no original Edison documents among them.

The paper we are removing is at least fifth generation duplicate photocopies of the original documents, and can easily be replaced by other photocopies. In fact, before the agency made the decision to eliminate these redundant copies, we requested and received permission to do so from the National Archives and Records Administration—the federal agency charged with preserving the nation's written history.

Personally, I have been a collector of historic American documents for over three decades. I would never allow any historical or relevant original documents to be purged from our archives. The U.S. patent system is as old as the Constitution. The first patent, issued in 1790, carries the signatures of George Washington and Thomas Jefferson. The original documents are national treasures; the fifth, tenth, or one hundredth photocopy usually is rubbish.

Here is how documents are handled by our agency:

- Original patents are given to and become the property of the inventor.
- Original files, which contain all documents relevant to the patent, including a copy of the original patent, are kept by USPTO for 10 years, then kept by the Federal Records Center for an additional 40 years, and are finally sent to the National Archives.
- USPTO keeps a paper set of all patents, and a duplicate set on microfilm in a secure cave in Pennsylvania.

- The public has free access to view and print the nearly 6.5 million patents that have been issued since 1790 on USPTO's Web site at www.uspto.gov.
- Additional paper photocopies of all patents also are available to the public in the USPTO's search room in Arlington, VA. The public is able to make additional photocopies of any of these documents.

The USPTO's entire staff — from its managers to its patent examiners — have a profound respect for U.S. patent history. It is reflected in the professional way they are managing and archiving America's treasure trove of original files.

Construction Underway for New USPTO Headquarters

by James Nowak, Office of Space Acquisition

The consolidation of the United States Patent and Trademark Office (USPTO) took another step forward on December 19, 2001, when the project developer, LCOR, successfully secured financing to build the agency's new headquarters in Alexandria, Virginia.

As a result, the construction phase of the project has officially started. LCOR has awarded contracts for excavation to Roy F. Weston, Inc. and construction to Turner Construction. Since September 2001, LCOR has engaged in a number of pre-construction activities on the 15-acre site, including relocation of utility lines and preliminary soil work for excavation.

Earlier, in July 2001, LCOR obtained approval from the City of Alexandria's Design Review Board for the exterior design of the facility, which the developer needed in order to close the project financing.

The first phase of USPTO occupancy is now scheduled for November/December 2003 with full occupancy expected by mid 2005.



Artist's rendering of new USPTO headquarters main building.

Mail to USPTO Disrupted

by Nick Godici, Commissioner for Patents

The discovery of anthrax at a number of mail facilities this past fall significantly disrupted mail service in many organizations across the United States. The United States Patent and Trademark Office (USPTO) is one such organization that is still feeling the effects. While the tests at the USPTO showed no evidence of anthrax in our facilities, the disruption to regular mail flow into the office is still

apparent. The USPTO has utilized various means to address the situation.

On October 21, 2001, the U.S. Postal Service closed the Brentwood postal facility and embargoed some mail that was in that post office over that weekend. The Brentwood facility, up to that point, handled the bulk of the mail going to and from the patents portion of the USPTO. The Merrifield post office handles the vast majority of the mail addressed to the trademarks portion of the office, and has not been effected by the events surrounding the Brentwood facility.

Following the closing of the Brentwood post office, the patents area of the USPTO did not receive any mail for 13 consecutive business days. When mail did resume in early November, the rate was significantly less than the normal daily levels. Subsequently, on November 16, 2001, the postal service temporarily stopped accepting Express Mail addressed to certain Washington D.C. zip codes, including the 20231 zip code assigned to the Commissioner for Patents.

Throughout this time, the USPTO has been keeping its customers apprised of the latest available information through postings on the Web site, which can be found at www.uspto.gov. A yellow highlighted page marker titled, "USPTO Mail & Other Emergency Related Info" provides a link for Web site visitors to select the latest postings that are most appropriate for their situation. Postings such as the notification of the temporary suspension of Express Mail service to the USPTO, identification of the USPTO's temporary new address, and questions and answers regarding the Express Mail situation can be located easily.

The office also has posted information on the various mailing alternatives such as fax numbers to enable contact with each of the patents technology centers, the use of surface mail with certificates of mailing (37 CFR 1.8) and express mailing certificates (37 CFR 1.10), and the use of the Internet and the Electronic Filing System (EFS) to file new patent applications. A posting also has been made to advise practitioners to monitor their deposit account information if they are replenishing accounts with checks sent by surface mail.

Recently, mail receipt by the patents area is increasing as new mail is received through the temporary Virginia P.O. Box, as well as new and delayed mail with October postage marks addressed to the

standard 20231 zip code. We ask that our customers bear with us as we address these challenges and monitor our Web site in order to stay informed of new developments that may ease the disruption and consequences of the recent mail delivery delays.

A MATTER OF CLASS

Changes in the International Classification of Goods and Services Based on the 8th Edition of the Nice Agreement

compiled by Joyce Ward, Office of Public Affairs

The purpose of international classification is to group like or related goods and services in one class. International trademark classification is established by the Committee of Experts of the Nice Union and is set forth in the *International Classification of Goods and Services for the Purposes of the Registration of Marks* manual, which is published by the World Intellectual Property Organization (WIPO). What was formerly International Class (IC) 42 was too broad to accomplish that purpose.

Former IC 42, which literally included “services that cannot be classified in other classes,” essentially became a warehouse for a myriad of unrelated services. Jessie Marshall, the USPTO’s administrator for trademark identification, classification and practice, points out that the former IC 42 included services as diverse as “brain surgery and horoscope casting.” Additionally, the “miscellaneous class” designation of former IC 42 allowed for the acceptance of broad and often imprecise identifications.

The effect of the 8th Edition of the Nice Agreement is to reorganize IC 42 and add three new service classes to the existing classification system. The following is a summary of the services now included in ICs 42-45:

Class 42 Scientific and technological services and research and design relating thereto; industrial analysis and research services;

design and development of computer hardware and software; legal services.

Class 43 Services for providing food and drink; temporary accommodation.

Class 44 Medical services; veterinary services; hygienic and beauty care for human beings or animals; agriculture, horticulture and forestry services.

Class 45 Personal and social services rendered by others to meet the needs of individuals; security services for the protection of property and individuals.

The changes in IC 42 and the addition of the three new classes will require precision in service identifications that will result in clearer parameters of protection for trademark registrations.

Class designations in trademark applications filed prior to January 1, 2002, are still governed by the class requirements under the 7th Edition of the Nice Agreement. Trademark applications filed on or after January 1, 2002, must comply with the classification requirements of the 8th Edition of the Nice Agreement. Trademark owners filing applications prior to January 1, 2002, have the option of amending their applications to comply with the requirements under the 8th Edition of the Nice Agreement. Applicants choosing to do so must advise the assigned examining attorney.

To obtain further information on the classification changes and the effect on U.S. ID/Classification Policy, visit the following links on the USPTO Web site:

<http://www.uspto.gov/web/offices/tac/notices/classchngs.html>

<http://www.uspto.gov/web/offices/tac/notices/servclas.html>

The USPTO will continually update the Identification of Goods and Services Manual to reflect the class changes. In addition, the office will update the notices on the Web site to reflect issues and policy changes arising as a result of the new classifications.

For more information on the World Intellectual Property Organization, visit the WIPO Web site at <http://www.wipo.org/>. A listing of the International Classifications may be found at <http://classifications.wipo.int/fulltext/nice8/enmain.htm>.

Helpful Hints

for trademark applicants

Electronic Correspondence Encouraged

In view of the recent disruption of mail service in some areas of the country, the trademark organization would like to encourage its customers to communicate electronically with the office.

Customers are encouraged to respond to office actions by e-mail and to submit other correspondence relating to existing applications and registrations via e-mail as well. Correspondence sent by e-mail should include the application serial or registration number in the subject line of the message addressed to the office. For a complete listing of USPTO email addresses by office, visit the USPTO Web site at: <http://www.uspto.gov/september11/tmemailnotice.htm>.

Additionally, applicants may submit trademark applications electronically using the Trademark Electronic Application System (TEAS) via the USPTO Web site. The office does not accept trademark applications by e-mail; however, information for filing trademark applications electronically is available through the Web site at: <http://www.uspto.gov/teas/index.html>. Electronic forms are available for submitting the following trademark applications:

- Trademark/Service mark Application, Principal Register
- Statement of Use/Amendment to Allege Use for Intent-to-Use Application
- Request for Extension of Time to File a Statement of Use
- Declaration of Use of a Mark Under Section 8
- Combined Declaration of Use Application for Renewal of Registration of Mark under Sections 8 & 9
- Declaration of Incontestability of a Mark Under Section 15.

For Your Reference

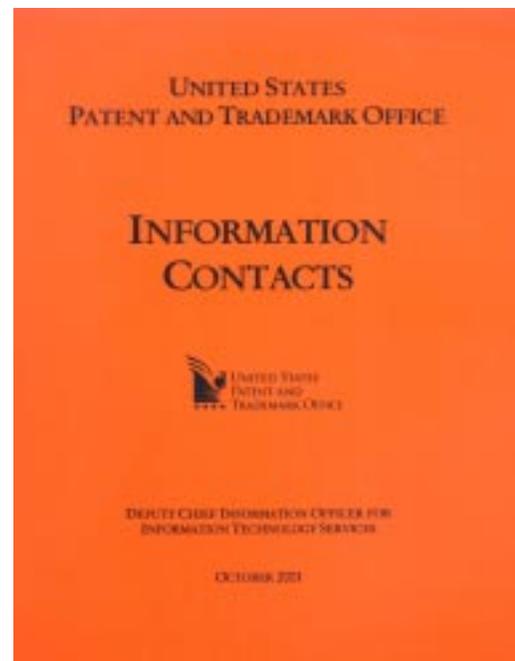
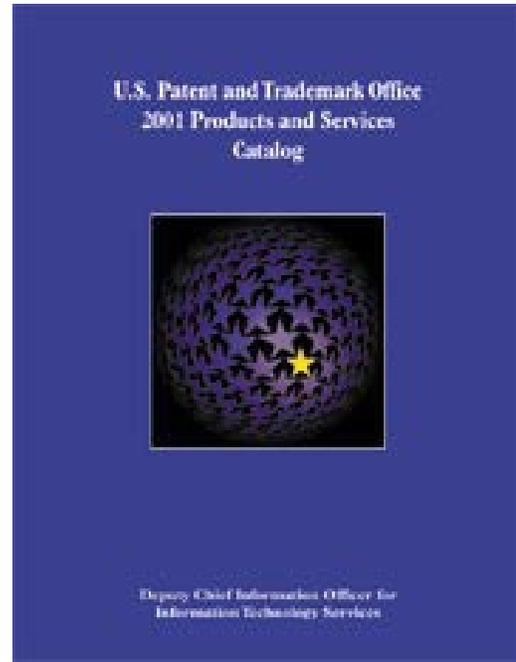
Publications Available from the USPTO

The *U. S. Patent and Trademark Office 2001 Products and Services Catalog* highlights patent and trademark related products and services available from USPTO. The catalog also includes items from the Superintendent of Documents (SuDocs), U.S. Government Printing Office, when offered on media not available through USPTO.

This print publication provides detailed product descriptions, information on copy/document sales, and on-site search facility services. The on-line edition, with links to related services, is found on the USPTO Web site at www.uspto.gov/.

Products are available in print, in various media including CD-ROM, DVD-ROM, VHS video cassette, 3480 cartridge tape, digital linear tape cartridge, on-line by subscription from USPTO's Data File Delivery FTP site, or via the Web site at www.uspto.gov/. Individual product descriptions include all media options with product codes, prices, and order information. The catalog also is an excellent source of information about a variety of USPTO services.

Another of USPTO's most popular publications is the *Information Contacts* telephone directory. The print and on-line directories provide telephone, fax, and TTY numbers listed alphabetically by subject. Also included are an alphabetical list of USPTO organizations; quick reference listings for frequently called patent, trademark, and general information; the patent technology centers and trademark law offices; special box addresses for patent,



trademark, and fee payment mail, and telephone numbers for each patent and trademark depository library. The on-line directory also provides links to a map of Crystal City, the USPTO employee locator, and the Department of Commerce person finder.

You may request copies of the *U. S. Patent and Trademark Office 2001 Products and Services Catalog* or the *Information Contacts* from the USPTO General Information Services Division by calling 800-786-9199 (in the U.S. or Canada) or 703-308-4357 for assistance from customer service representatives and/or access to the automated information message system, via e-mail at usptoinfo@uspto.gov, or in writing to:

General Information Services Division
U.S. Patent and Trademark Office
Crystal Plaza 3, Room 2C02
Washington, DC 20231

Please provide the name of the publication, the number of copies you would like, and complete delivery information.

Top Ten Patenting Organizations for Calendar Year 2001

The chart below presents a preliminary list of the corporations that received the most utility patents during the 2001 calendar year. Two U.S. corporations, seven Japanese corporations, and one corporation from the Republic of Korea make up the top 10.

For the ninth consecutive year, International Business Machines Corporation (IBM) ranks first among non-federal patenting organizations. IBM received 3,411 utility patents for the year, up 18 percent from its total for the year 2000.

The U.S. government received 954 utility patents for the year which would rank it 16th among the top patenting organizations for 2001.

**PRELIMINARY LIST OF TOP PATENTING ORGANIZATIONS *
Calendar Year 2001**

Preliminary Rank in 2001*	Preliminary # Patents in 2001*	Organization*	(Final Rank) (in 2000)	(Final Number of) (Patents in 2000)
1	3,411	International Business Machines Corporation	(1)	(2,886)
2	1,953	NEC Corporation	(2)	(2,021)
3	1,877	Canon Kabushiki Kaisha	(3)	(1,890)
4	1,643	Micron Technology, Inc.	(7)	(1,304)
5	1,450	Samsung Electronics Co., Ltd.	(4)	(1,441)
6	1,440	Matsushita Electric Industrial Co., Ltd.	(11)	(1,137)
7	1,363	Sony Corporation	(6)	(1,385)
8	1,271	Hitachi, Ltd	(13)	(1,036)
9	1,184	Mitsubishi Denki Kabushiki Kaisha	(14)	(1,010)
10	1,166	Fujitsu Limited	(10)	(1,147)
	954	U.S. GOVERNMENT		(928)

* The listed patent counts are preliminary counts which are subject to correction. The final listing of patent counts for the top patenting organizations in 2001 should be available by early April.

Patent information presented reflects patent ownership at patent grant and does not include ownership changes that occur after the patent grant. Where more than one assignee (owner) exists, patents are attributed to the first-named assignee.

SOURCE: U.S. Patent and Trademark Office
Technology Assessment and Forecast database (1-4-2002)

USPTO Customer Outreach

E-Government/Trademark Electronic Filing Seminars

The United States Patent and Trademark Office (USPTO) and the Patent and Trademark Depository Libraries present, “The Trademark Office Goes E-Government,” a series of outreach seminars designed to educate customers about the transition of the trademark operation to an e-government office.

Since 1997, the trademark office has been advancing its business model from a paper-based process to one that utilizes information technology to provide higher quality processing and examination of trademark applications. As the office moves closer to its strategic

goal of operating a fully electronic workplace, these seminars will provide an opportunity for the customers to learn the process first-hand from USPTO leaders. Each seminar will include an extensive demonstration of the USPTO's award-winning Trademark Electronic Application System (TEAS). Participants will be able to ask questions about TEAS and receive user perspectives from actual e-trademark filers.

Seminars are currently scheduled in Los Angeles, New York City, Philadelphia, Fort Lauderdale and Cleveland. The commissioner of trademarks, Anne H. Chasser, and TEAS project manager, Craig K. Morris, will conduct the seminars.

The first session will be held on February 7, 2002, in the Mark Taper Auditorium of the Los Angeles Public Library. The second seminar will be held on February 22, 2002, at the Celeste Bartos Forum of the New York Public Library. The seminars are free to the general public and registration is not required, with the exception of the New York City session where there is a registration requirement. Each seminar begins at 9:00 a.m. and lasts until noon.

For general information about the seminars, contact Craig Morris by phone at (703) 308-8910, ext. 136, or via e-mail at craig.morris@uspto.gov. For a complete listing of the dates and locations of future seminars, visit the USPTO Web site at <http://www.uspto.gov/web/trademarks/egov.htm>.

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